



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/145,381	09/01/98	SAUTER	T KTW0111889

PM82/0608

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EXAMINER

PHAN, H

ART UNIT

PAPER NUMBER

3619

DATE MAILED:

06/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/145,381

Applicant(s)

SAUTER, TOM

Examiner

Hau V Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-27 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14, 15, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) 10-13, 16-19, 22-27, 29-34 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
- ☐ received.
 - ☐ received in Application No. (Series Code / Serial Number) _____.
 - ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892) 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 18) ☐ Notice of Informal Patent Application (PTO-152)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 19) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 3718 of this title before the invention thereof by the applicant for patent.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by any one of Roman et al., or Nicoletti, or Wilder.

Nicoletti discloses a skate frame (21) for an inline skate comprising an elongate first structural member (9) having first (17) and second (18) sidewalls depending downwardly from a first upper surface (12), the lower ends of the sidewalls being spaced to receive wheels (11) therebetween, and vibration dampening means (8,9) integrally formed with the sidewalls of the first structural member (17, 18) for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface.

Roman et al. discloses a skate frame for an inline skate (2) comprising an elongate first structural member (15) having first (8) and second sidewalls (9) depending

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downwardly from a first upper surface (See Fig 3), the lower ends of the sidewalls being spaced to receive wheels (14) therebetween, and vibration dampening means integrally formed with the sidewalls of the first structural member (2) for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface (see Fig 2).

Wilder discloses a skate frame (10) for an inline skate comprising an elongate first structural member (2) having first (20) and second (22) sidewalls (See Fig 2) depending downwardly from a first upper surface (12,14), the lower ends of the sidewalls being spaced to receive wheels (See Fig 1,2,3) therebetween, and vibration dampening means (36,44) integrally formed with the sidewalls (20,22) of the first structural member (20,22) for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface.

3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Malewicz.

Regarding Claim 1, Malewicz discloses a skate frame (32) for an inline skate (10) comprising an elongate first structural member (14) having first (32) and second (34) sidewalls (See Fig 2) depending downwardly from a first upper surface (293), the lower ends of the sidewalls being spaced to receive wheels (16) therebetween, and vibration dampening means (130,160) integrally formed with the sidewalls (32,34) of the first structural member (14) for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface.

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Regarding claim 2, Malewicz further discloses that the vibration dampening means comprises a contoured portion (130, 160) of each of the first (32) and second (34) sidewalls of the first structured member (14), the contoured portion (160) having a predetermined cross-sectional shape to permit the sidewalls to flex (impliedly disclosed at col 6, lines 1-15; Malewicz discloses a flexible, lightweight fiberglass polyamide frame) thereby absorbing at least a portion of the vibrational energy associated with traversing the surface.

Regarding Claim 3, Malewicz further discloses that the cross-sectional shape of the first and second sidewalls is substantially arcuate (see fig 6) such that the contoured portion of the sidewalls flexes to absorb at least a portion of the vibrational energy.

Regarding claim 4, Malewicz further discloses that the arcuate cross-sectional shape of the first and second sidewalls is substantially C-Shaped in configuration (see fig 2), the arcuate cross-sectional shape having an upper end (200) spaced from a lower end (110) by a concave portion (136).

Regarding claim 5, Malewicz further discloses that the concave portion (136) of the first sidewall (32) faces the concave portion (166) of the second sidewall (34) in an opposed manner such that the first structural member (12) is tubular.

Regarding Claim 6, Malewicz further discloses a second structural member (110, 118) having first (115) and second (123) sidewalls held in parallel disposition by a second upper wall, the second structural member having an open lower end sized to receive the wheels (16A) therebetween, the second structural member having a width

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(41) sized to be received within the first structural member such that the sidewalls of the first structural member (32) overlap at least a portion of the sidewalls of the second structural member (see Fig 2).

Regarding claim 7, Malewicz further discloses that the vibration dampening means comprises a contoured portion (170) of each of the first and second sidewalls (32, 34) of the first structural member, the contoured portion having a predetermined cross sectional shape to permit to sidewalls to flex, thereby absorbing at least a portion of the vibrational energy associated with traversing the surface.

Regarding claim 8, Malewicz further discloses that the cross-sectional shape of the sidewalls of the first (32) and second (34) structural members is substantially arcuate (see Fig 2), such that the arcuate cross-sectional shape of the sidewalls flexes to absorb at least a portion of the vibrational energy (Col 3, line 65- Col 4, line 10), wherein the arcuate cross-sectional shape of the first and second sidewalls is substantially C-shaped in configuration, the arcuate cross-sectional shape of each sidewall has an upper end spaced from a lower end by a concave portion.

Regarding claim 9, Malewicz further discloses that the concave portion (136) of the first sidewall (32) of the first (upper, curved 32) and second (110) structural members faces the concave portion of the second sidewall of the first (118) and second (upper, curved 34) structural members in an opposed manner. See Fig 2.

4. Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Malewicz.

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a) an elongate first structural member (14) having downwardly depending first (32) and second (34) sidewalls, the lower ends of the sidewalls being spaced to receive wheels (16) therebetween;

b) an elongate second structural member (110, 118) having downwardly depending first (112, 120, respectively) and second (115, 123, respectively) sidewalls, the sidewalls of the second structural (110, 118) member being spaced to receive the first and second structural member there between, such that the sidewalls of the second structural member overlap at least a portion of the sidewalls of the first structural member (see fig 2);

c) and vibration dampening member (130, 160) integrally formed with the sidewalls (32, 34) of the first and second structural members (32, 14) for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface.

Regarding claim 15, Malewicz further discloses that the vibration dampening member comprises contouring the sidewalls of both the first and second structural members to a predetermined cross-sectional shape to permit the sidewalls to flex, thereby absorbing at least a portion of the vibrational energy associated with traversing the surface. Col 6, lines 1-15.

5. Claims 20, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Malewicz.

Malewicz discloses a skate frame comprising the following:

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a) an elongate carrier frame (14) having first (32) and second (34) sidewalls held in spaced parallel disposition by a first upper wall (32) and an open lower end spaced to receive the wheels (16) therebetween; and,

b) an elongate outer shell (110, 118) having first (112, 120, respectively) and second (115, 123, respectively) sidewalls and an open lower end, the sidewalls of the outer shell (110, 118) overlap at least a portion of the sidewalls of the carrier frame (14), the sidewalls of the carrier frame and the outer shell having a predetermined cross sectional shape to permit the sidewalls to flex, thereby absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface.

Regarding claim 21, Malewicz further discloses that the cross-sectional shape of the sidewalls (32, 34) of the carrier frame (14) and the outer shell is substantially arcuate (see fig 2 or 6), such that the arcuate cross-sectional shape of the sidewalls flexes to absorb at least a portion of the vibrational energy, wherein the arcuate cross sectional shape of the first and second sidewalls of the carrier frame and the outer shell is substantially C-shaped in configuration, the arcuate cross-section of each sidewall has an upper end spaced from a lower end by a concave portion. See fig 2 or 6.

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Allowable Subject Matter

6. Claims 10-13, 16-19, 22-27, 29-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed on 4/14/00 have been fully considered but they are not persuasive. Regarding claim 1, 14, 20, 26 and 34 applicant submits a Declaration under 37 C.F.R 1.131, filed herewith, to antedate the reference of Artus. The examiner agrees and withdraws the Artus's rejection. Regarding claim 1 applicant argues that there is no teaching or suggest a skate frame having flexible vibration dampening means for absorbing at least a portion of vibration energy associated with traversing a surface in the invention of Roman et al., Nicoletti and Wilder et al. The examiner disagree because Roman et al. Nicoletti and Wilder et al. teach the skate frame having flexible vibration. Therefore, the rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by any one of Roman et al., or Nicoletti, or Wilder as set forth above is still considered to be proper.

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Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Hau Phan whose telephone number is (703) 380-2084. In the event efforts to reach the examiner are unsuccessful, the applicant may contact the examiner's supervisor, Lanna Mai, at (703) 308-2486.

HP

6/5/2000


MICHAEL MAR
PRIMARY EXAMINER 6-5-00